

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Robin Torres

(Type or print name of person mailing paper)

Date:

April 21, 1999

Robin Torres

(Signature of person mailing paper)



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of	)	Group Art Unit: 1614
	)	
Arimilli et al.	)	Attorney Docket No. 221.P1C
	)	
Serial No: 09/187,763	)	Examiner: M. Ambrose
	)	
Filed: November 6, 1998	)	
	)	
Title: Antiviral Phosphonomethoxy Nucleotide	)	
<u>Analogues Having Increased Oral Bioavailability</u>	)	

TERMINAL DISCLAIMER

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Gilead Sciences, Inc., a Delaware corporation, having an address at 333 Lakeside Drive, Foster City, California 94404, certifies to the best of Gilead's knowledge and belief that Gilead Sciences, Inc. is the owner of the entire right, title and interest to U.S. application serial No. 09/187,763 (hereafter '763), and U.S. application serial No. 08/900,746 (hereafter '746); evidence of ownership of '763 and '746 is the assignment recorded on January 26, 1998 at Reel 8929, Frame 0225.

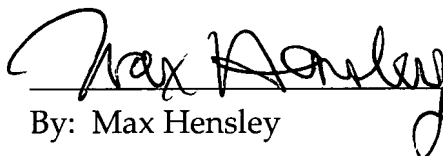
Gilead Sciences, Inc. hereby disclaims the terminal part of any patent granted on '763 which would extend beyond the expiration date of any patent to issue on '746 and agrees that any patent granted on the '763 application will be enforceable only during

the period that the legal title to any patent issuing on the '746 patent application is the same as the legal title to any patent granted on '763. This agreement runs with any patent granted on '763 and is binding on Gilead Sciences, Inc., its successors or assigns.

Gilead Sciences, Inc. does not disclaim any terminal part of any patent that issues on '763 prior to its expiration date as presently shortened by this terminal disclaimer of the '746 application in the event that any patent granted on the '746 application (1) expires for failure to pay a maintenance fee, (2) is held unenforceable or found invalid by a court of competent jurisdiction and all appeals from that court's final judgment are exhausted, (3) is disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), (4) has all claims canceled by a reexamination certificate, or (5) is otherwise terminated prior to its statutory term.

Please charge Deposit Account No. 07-1250 the sum of \$110.00 and for any fee deficiency which may be due. A duplicate of this disclaimer is attached.

Dated: April 21, 1999



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By: Max Hensley

Title: Vice President for Intellectual Property

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SUBJECT DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

DATE: 4-27-99

APPL. S.N.: 091187763

TO EXAMINER: M. Ambrose

ART UNIT: 1614

M. MONTGOMERY ROOM 1E18

MAILROOM DATE 4-23-99

AFTER FINAL YES ☐ NO ☒ NUMBER OF T.D(S). FILED 1

**INSTRUCTIONS:** I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$\_\_\_\_\_ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity. (See 14.28).

☐ is not recognized as an officer of the assignee. (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: \_\_\_\_\_

☐ Suggestion to request refund of \$ \_\_\_\_\_. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)